REMARKS

Claims 2-9 are pending and stand rejected in the above-captioned application. Claim 2 has been amended.

I. Rejections Under 35 U.S.C. §102(a)

Claims 2-4, 6, 8, and 9 were rejected under 35 U.S.C. §102(a) as allegedly being anticipated by U.S. Patent No. 5,779,868 ("Parce"). Amended claim 2 contains the element of "a conductive layer deposited on at least a portion of a surface of the capillary element, the conductive layer extending from a point proximal to the first end of the capillary element up to the second end of the capillary element." Note that support for the added terminology "proximal to the first end" can be found in the pending Application on pg. 5 lines 23-27. The "second end of the capillary" is the end opposite where the capillary is attached to the "body structure" of the microfluidic device. In other words, the "second end" is the end of the capillary that is placed into a liquid sample. Thus amended claim 2 requires that a single "conductive layer" extend from "proximal to the first end" all the way to the "second end" of the capillary.

To anticipate a claim under §102(a), a reference must teach every element of the claim. MPEP 2131. The portions of Parce cited by the Examiner do not anticipate as-amended claim 2. In Figure 4A of Parce, the conductive layer 252 does not extend all the way from a point proximal to the "first end" (i.e. the end at the top of the figure) all the way to the "second end" (the end at the bottom of the figure). Instead, the conductive layer 252 contacts a "ring" 253 before reaching the "second end". It is this "ring", not the conductive layer, that extends all the way to the "second end" to make contact with a sample fluid. See Parce Col. 8 Lines 51-55. Thus, Parce does not appear to disclose conductive layer extending from a point proximal to the first end of the capillary element up to the second end of the capillary element." If Parce does not anticipate claim 2, then Parce cannot anticipate any of the claims dependent from claim 2. Thus Applicant asserts that claims 2-4, 6, 8, and 9 are allowable over Parce.

II. Rejection Under 35 U.S.C. §103(a)

Claims 5 and 7 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chow U.S. Pat. 6,149,787 ("Chow") in view of Parce. Applicant respectfully traverses for the following reasons.

35 U.S.C. Section 103(c), effective November 29, 1999, provides:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c) applies to all applications filed on or after November 29, 1999 including continuing applications filed under 37 CFR 1.53(b). See MPEP Section 706.02(k).

The instant application was filed on September 14, 2000 as a continuing application under 37 CFR 1.53(b), so the provisions of 35 U.S.C. § 103(c), effective November 29, 1999, apply to it. Under 35 U.S.C. § 103(c) noted above, a reference which qualifies as prior art only under 35 U.S.C. § 102(e) (in addition to §§ 102(f) or (g)) and that is commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). In the present case, the Examiner's 103(a) rejection primarily relies on the Chow reference that was filed on October 14, 1998, and issued on November 21, 2000. The present application was filed as a continuing application on September 14, 2000 and is a continuation of U.S. Patent Application No. 09/267,428, filed March 12, 1999. Thus, the Chow reference only qualifies as prior art under § 102(e) (and/or § 102(f) or (g)). In addition, both the instant application and the Chow reference were commonly owned by the same present assignee, Caliper Technologies Corp., at the time the claimed invention of the present application was made. Accordingly, the Chow reference cannot be applied in a rejection under 35 U.S.C. § 103(a) under the provisions of 35 U.S.C. § 103(c).

Since Chow does qualify as § 103(a) art, and since Parce alone does not appear to anticipate claims 5 and 7, those claims should be allowed over the art of record.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe that the present application is in condition for allowance and action toward that end is respectfully requested. If the Examiner believes that a telephone interview would expedite the examination of this application, the Examiner is requested to contact the undersigned at the telephone number below.

Respectfully submitted,

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